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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,855	08/21/2003	Tadahiro Ohmi	8075-1055-1	1521

466 7590 08/20/2010
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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1784

NOTIFICATION DATE	DELIVERY MODE
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08/20/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/646,855
Filing Date: August 21, 2003
Appellant(s): OHMI ET AL.

Robert A. Madsen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 7, 2010 appealing from the Office action mailed December 7, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 3 and 5-7.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

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(6) Grounds of Rejection to be Reviewed on Appeal

Claims 3 and 5-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

NEW GROUND OF REJECTION

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkinson (U.S. Patent 3,480,483) in view of Ohmi (EP 0725160 A1).

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 3 and 5-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. There appears to be no support in the original disclosure for the limitation "said coating material having a thickness of at least 100 nm" (e.g. independent claim 3, lines 6-7).

NEW GROUND OF REJECTION

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. There appears to be no support in the original disclosure for the limitation "a chromium coat film having an outermost surface and a depth comprising a distance of 100 nm from said outermost surface" (e.g. independent claim 7, lines 6-8).

(10) Response to Argument

Claims 3 and 5-6 are rejected under 35 U.S.C. 112, first paragraph, since there appears to be no support in the original disclosure for the limitation "said coating material having a thickness of at least 100 nm " (e.g. independent claim 3, lines 6-7). Appellant has pointed to

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Figure 2 for support for this limitation (see pages 6-7 of appellant's brief), but at best, Figure 2 can only provide support for a coating material having a thickness value in the range illustrated by the figure. It is unclear how Figure 2 can provide support for thicknesses that are not illustrated in the figure (i.e. a range of thicknesses over 100 nm). The claim language is drawn to thickness values equal to or over 100 nm and Figure 2 does not show any embodiments having thicknesses over 100 nm. Appellant's amendment has established a new thickness range of "at least 100 nm" that did not exist in the original disclosure. In any event, it should be noted that "said coating material" in the claims (e.g. claim 3, line 6) is a "a coating material consisting of chromium" (e.g. claim 3, line 4) and Figure 2 does not illustrate the claimed chromium coating material but rather Figure 2 illustrates the "chromium oxide passivation film after oxidizing treatment" (e.g. see page 4 of the specification at lines 24-26). Thus Figure 2 does not correspond to the "coating material consisting of chromium" (e.g. claim 3, line 6) in the claims, but rather Figure 2 corresponds to the "chromium-oxide passivation film" (e.g. claim 3, line 13). It is noted that there is no evidence of record of a direct 1:1 correlation in thicknesses between the thickness of the original "coating material consisting of chromium" and the final thickness of the "chromium-oxide passivation film". Thus it is unclear how Figure 2 can support a particular thickness of the original chromium film as claimed. Therefore, barring evidence of support elsewhere in the original disclosure, the amended matter is considered new matter that is unsupported by the original disclosure.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This is a new rejection, but it relates to the same lack of support issues present in the rejection of claims 3 and 5-6, above, and thus should be decided at the same

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time. There appears to be no support in the original disclosure for the limitation "a chromium coat film having an outermost surface and a depth comprising a distance of 100 nm from said outermost surface" (e.g. independent claim 7, lines 6-8). As discussed above, appellant argues that Figure 2 establishes support for the chromium coating material thickness range of "at least 100 nm". The examiner notes that if Figure 2 shows an embodiment that establishes support for thicknesses over 100 nm (claim 3, line 7), it is unclear how the same Figure 2 can also show an embodiment that establishes support for "an outermost surface and a depth comprising a distance of 100 nm from said outermost surface" (e.g. independent claim 7, lines 6-8). In addition, it should again be noted that Figure 2 does not describe the "coating material consisting of chromium" (e.g. claim 7, line 4) in the claims, but rather describes the "chromium-oxide passivation film" (e.g. claim 7, line 14). It is again noted that there is no evidence of direct 1:1 correlation in thicknesses between the thickness of the original "coating material consisting of chromium" and the final thickness of the "chromium-oxide passivation film". Therefore, it is unclear how Figure 2 supports a particular thickness of the original chromium film as claimed. Barring evidence of support elsewhere in the original disclosure, the amended matter is considered new matter that is unsupported by the original disclosure.

The prior rejection of claims 3 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over Wilkinson (U.S. Patent 3,480,483) in view of Ohmi (EP 0725160 A1) has been withdrawn in view of appellant's arguments. Specifically, the applied prior art fails to adequately meet the surface roughness (Ra) limitation of "not more than 1.5 μm " in the pending independent claims.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent

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applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/John J. Zimmerman/
Primary Examiner, Art Unit 1784

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Gregory L Mills/
Supervisory Patent Examiner, Art Unit 1700

Conferees:

/Jennifer C. McNeil/
Supervisory Patent Examiner, Art Unit 1784

/Gregory L Mills/
Supervisory Patent Examiner, Art Unit 1700